

## **REMARKS**

### **1) Summary of Office Action**

The Applicant thanks the Examiner for the Examiner's Office Action of September 22, 2004 in which:

(a) The requirement for restriction was made 'Final', and in that regard of claims 1 – 49 pending in the case, claims 2, 9, 12–29, 36, 37, 39–41, and 43–49 were withdrawn from consideration.

(b) All of the claims not withdrawn by the Examiner, namely claims 1, 3–8, 10, 11, 30–35, 38 and 42 were rejected. The rejections were:

- (i) Anticipated under 35 USC 102 by US P 5,343,812 of Ishida – Claims 1, 3 7 and 8.
- (ii) Anticipated under 35 USC 102 by US P 3,399,631 of Weber – Claims 1, 3–5, 7, 8, 10, 11, 30–32, 38 and 42.
- (iii) Obvious under 35 USC 103 given US P 3,399,631 of Weber in view of alleged common sense – Claims 33–35; and
- (iv) Obvious under 35 USC 103 given US P 3,399,631 of Weber in view of US P 5,207,161 of Pilleggi – Claims 6.

### **2) Requirement for Restriction Made Final**

The Applicant notes that the Requirement for Restriction has been made 'Final'. Accordingly, the Examiner has withdrawn claims 2, 9, 12–29, 36, 37, 39–41, and 43–49 from consideration.

The Examiner points out that the number of claims (49) may present a significant searching burden. The Applicant respectfully acknowledges that the number of claims was perhaps more than customary. However, the Applicant respectfully wonders whether, for example, the burden of searching required to examine claim 2 would be any different from the burden of searching required to examine claim 3, or whether the burden of searching required to examine claim 9 would be any different from the searching burden for claim 8?

In the event that the Examiner may reconsider whether these or others of the remaining withdrawn claims might be examined without undue burden, the Applicant would appreciate the examination of any of those additional claims presently identified as being withdrawn.

3) **Rejections Based on Ishida (US P 5,343,812)–Claims 1,3,7 and 8–Insufficient Disclosure**

While the Applicant appreciates the basis of the rejections made under 35 USC 102 in light of Ishida, the Applicant respectfully doubts whether Ishida is an anticipatory reference.

The test for anticipation requires that the anticipatory reference place the a person of ordinary skill in the art, but lacking in inventive ingenuity, in possession of the invention in such a way as would permit that person to practice the invention.

Can it really be said that Ishida does this?

It is possible that Ishida may have had a conceptual idea. However, the Applicant respectfully submits that Ishida's disclosure is insufficient to provide any reasonable level of enablement to the person of ordinary skill in the art. Other than the references to other documents, what is there in the Ishida's very generalized, non-specific, and non-detailed description and illustrations that would distinguish the construction of the railcar units that Ishida proposes from a child's toy made of wooden blocks ? How is one to know? Ishida doesn't say.

In summary, the Applicant respectfully submits that, however attractive Ishida may initially and superficially appear as a reference, Ishida lacks sufficient enabling description to support a rejection under 35 USC 102. In particular, Ishida does not show articulated connectors between the railcar units as the term would commonly be understood by persons of ordinary skill in the art in North America.

4) **Rejections based on Weber (US P 3,399,631) – Claims 1,3–5,7,8,10,11,30–32,38,42**

In the rejection, the Office Action states:

“Weber Figures 1 and 2, shows a multi-unit articulated railroad car as recited in the instant claims, including side bearing arms 72, 73, 76, 77 articulated connectors 11 with male and female portions 18, 17 on trucks 9, 10 and the articulated connectors as shown in Figure 1, and the side bearing arms as shown in Figure 2, are in symmetrical arrangements relative to the transverse centerline as claimed.”

The Applicant respectfully disagrees.

Weber Figure 1 is a schematic diagram that tells us that there are at least four units, 4, 5, 6, and 7. There are articulated connectors between the four units. Weber Figure 1 tells us nothing about the connection between units 5 and 6, or between such additional intermediate units as there may be between units 5 and 6. Therefore, it cannot be said that Figure 1 shows that the articulated connectors of the railroad car shown are symmetrical about the transverse axis: it simply doesn't show the other connections.

However, Weber Figure 13 does show a connection between unit 5 and unit 6, and a connection between unit 4 and unit 5. At the connection between unit 6 and unit 5, to the extent that the not overly detailed and rather schematic illustration can be said to show anything, it appears to indicate that the male portion of the connector is mounted to unit 6, and the female portion is mounted on unit 5. Similarly, the connection between unit 5 and unit 4 shows that the male portion of the connector is on unit 5 and the female portion is on unit 4.

Therefore, if the railroad car were to include only four units (being 4, 5, 6 and 7) then it could not satisfy the condition of having a symmetrical mounting arrangement of its connectors. (And would not, in any event, satisfy the condition that there be an un-even number of units). If the railroad car were to have more units, then the reader is no further ahead, since there is no information at all about those other units. It is a matter of trite law that a rejection under 35 USC 102 cannot be established on the basis of conjecture.

It may be noted that Figure 13 and the description of Figure 13, are directed toward the explanation of an alternate embodiment of side bearing arms, not toward an alternate embodiment of connectors. There is nothing in Weber's description that would either (a) indicate that the arrangement of articulated connectors has been made symmetrical; or (b) that there is anything to be gained by making the arrangement symmetrical. Weber does not discuss the subject at all. That is, there is nothing in Weber that shows, describes or suggests the desirability of employing a symmetrical arrangement of articulated connectors.

Therefore, the Applicant respectfully submits that however a person skilled in the art may interpret the Weber reference, it does not show or describe a railroad car in a manner sufficient to support a rejection under 35 USC 102. The Applicant respectfully submits that Weber does not anticipate any of claims 1, 3-5, 7, 8, 10, 11, 30-32, 38, or 42.

5) Rejections under 35 USC 103 Based on Weber (US P 3,399,631) – Claims 33-35

In view of the foregoing commentary with respect to Weber, the Applicant respectfully submits that grounds for the rejection of dependent claims 33 – 35 have not been established.

In passing, the Applicant notes that the test for obviousness set forth in MPEP 2142 requires that the features alleged be present somewhere in the cited art. This would appear to be so whether those features are alleged to be a matter of common sense or not.

6) Rejections under 35 USC 103 based on Weber in view of US P 5,207,161 of Pilleggi

In view of the commentary made above with regard to Weber, the Applicant respectfully submits that *prima facie* grounds for rejection of claim 6 under 35 USC 103 have not been established. In addition, the Applicant respectfully submits that there is nothing in Pilleggi that shows, describes, or suggests a symmetrical arrangement of articulated connectors.

7) Amendment to Claim 3

Claim 3 has been amended to correct grammatical inconsistencies.

8) Conclusion

The Applicant respectfully submits that the claims as presently pending are in a condition for allowance. The Applicant therefore requests reconsideration of the current rejections and early and favorable disposition of this application.

Respectfully submitted,

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